

### **REMARKS/ARGUMENTS**

Favorable reconsideration of this application is respectfully requested in view of the amendments made above and the remarks that follow. A petition for a one-month extension of time to and including August 7, 2006, and a Request for Continued Examination are submitted herewith, along with the requisite fees.

The indicated allowance of claims 9 and 10, and the indicated allowability of claims 5-8 subject to being rewritten to include the subject matter of the base claim and any intervening claims is noted and appreciated.

Regarding the objection to claims 1 and 4-11, it is not clear to applicant whether this is a formal rejection of those claims or merely the examiner's comment as to why she does not consider the language "swimming pool guard", "guard" and "skimmer" as positive limitations in the claims. Applicant has carefully reviewed the claims and believes them to be in compliance with 35 USC 112.

Regarding the use of the preamble to limit the claims, applicant is aware that preamble language merely extolling benefits or features of the claimed invention, or stating an intended use or purpose, ordinarily does not limit the claim scope, but see MPEP 2111.02 and cases cited therein. For example, in Catalina Mktg. Int'l v. Coolsavings.com, Inc., 289 F.3d at 808-09, 62 USPQ2d at 1785, it was held that ("*[C]lear reliance on the preamble during prosecution to distinguish the claimed invention from the prior art transforms the preamble into a claim limitation because such reliance indicates use of the preamble to define, in part, the claimed invention.*") Applicant clearly is relying upon the preamble limitation of his invention as a swimming pool skimmer guard to help distinguish over the prior art, and especially the patent to Ali, which is for an entirely different type of guard and which is not capable of functioning as a swimming pool skimmer guard with attaching means for attaching it to a substantially flat swimming pool wall.

See also Ex parte Futo, 59 USPQ 2d 1955 (BPAI 2000), wherein the preamble recitation of a wrench for a rotating plastic slip nut was considered to limit the claimed structure so that it distinguished over a prior art soda bottle wrench. Similarly, in Kropa v. Robie, 187 F.2d 150,

152, 88 USPQ 478, 481 (CCPA 1951), the court stated: "A preamble reciting 'An abrasive article' was deemed essential to point out the invention defined by claims to an article comprising abrasive grains and a hardened binder and the process of making it. The court stated 'it is only by that phrase that it can be known that the subject matter defined by the claims is comprised as an abrasive article. Every union of substances capable inter alia of use as abrasive grains and a binder is not an 'abrasive article.' Therefore, the preamble served to further define the structure of the article produced". The preambles in claims 1 and 11 as now amended call for a swimming pool skimmer guard with attaching means for attaching the guard to the wall of a swimming pool. These limitations are structural limitations of the claim. Further, this language is essential to an understanding of the scope of the claim and what is intended to be covered by the claim.

As set forth in MPEP 2111.02, the claim preamble must be read in the context of the entire claim. The determination of whether preamble recitations are structural limitations or mere statements of purpose or use "can be resolved only on review of the entirety of the [record] to gain an understanding of what the inventors actually invented and intended to encompass by the claim." Corning Glass Works, 868 F.2d at 1257, 9 USPQ2d at 1966.

It is clear from the record in this case that applicants invented a swimming pool skimmer guard and that is what they intend to encompass by the claims.

Moreover, independent claims 1 and 11 have been amended to better define the attaching means on the swimming pool skimmer guard, i.e., the attaching means is now defined as for attachment of the guard to a substantially flat wall surface of a swimming pool to support the guard in spanning relationship across a skimmer opening of the swimming pool. There is nothing in Ali (5,623,787) corresponding to this structure or capable of performing this function. The roof valley guard of Ali is not capable of attachment to a substantially flat wall surface. In Ali, the opposite edges of the guard are bent or flexed inwardly and engaged against the adjacent edges of roofing tiles to hold the guard in place.

To modify Ali to the extent necessary to make it have the structure and function of applicant's invention would render Ali unsuitable for its intended purpose, and this is

inappropriate modification of a reference. Moreover, there is no suggestion or motivation in Ali for making the proposed modifications.

The device disclosed by Ali (5,623,787) is a specialized device for placement in the valley of a tile roof. It is flexed into a U-shape and the opposite “legs” thereof are inserted and held between opposed rows of roofing tiles to hold the guard in place. The Ali device does not have attaching means for attachment of the guard to the wall of a swimming pool and it is not capable of functioning as a swimming pool skimmer guard. There is no suggestion in Ali of using the guard as a swimming pool skimmer guard, or of how the guard could be attached to a wall of a swimming pool, or of how the guard of Ali could be adapted to such use. Accordingly, the rejection of claims 1, 4 and 11 as obvious in view of Ali under 35 USC 103(a) should be withdrawn.

None of the patents of record disclose or suggest a swimming pool skimmer guard having attaching means for attaching the guard to the wall of a swimming pool in stationary position across a skimmer opening, and that is flexible or bendable so that it can be adjusted to fit different size skimmer openings.

To establish obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

In order to adapt the device of Ali or any of the other references of record to make them capable of functioning as a swimming pool skimmer guard as now claimed would require substantial modification and would change the principle of operation of those devices, making them unsatisfactory for their intended purpose.

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, or require a substantial reconstruction and

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redesign of the elements shown in the primary reference, then the teachings of the references are not sufficient to render the claims prima facie obvious. In re Ratti, 270 F.2d 810, 122 USPQ 349 (CCPA 1959).

If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

It is respectfully submitted that rejection of the currently amended claims as obvious in view of Ali would not be in compliance with applicable law, and the claims as now amended should be allowed.

Respectfully submitted,  
Dennis H. Lambert & Associates



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Dennis H. Lambert  
Reg. No. 25,017

DHL:cal

Dennis H. Lambert & Associates  
7000 View Park Drive  
Burke, Virginia 22015  
Tel: 703-451-1227  
Fax: 703-451-1297